



Signature of Person Mailing Paper

Notice of Concurrent Litigation

Pursuant to MPEP § 2001.06(c), the existence of litigation in a parent of the above-identified application is hereby being brought to the attention of the Patent & Trademark Office. Documents related to the litigation are enclosed herewith and listed on the accompanying form.

A. Items CA and CB

On April 30, 2004, a complaint for declaratory judgment of noninfringement and invalidity of Rando et al. U.S. Pat. No. RE37,166 (the 'RE'166 patent), the parent to the present application, was filed in United States District Court for the Southern District of Ohio at Dayton. The suit is identified as NCR Corporation v. PSC, Inc. and PSC Scanning, Inc., Case No. 3:04cv0142. The plaintiff, NCR Corporation, alleges at paragraph 33 that:

“On information and belief, claims of the Asserted Patents are invalid, inter alia, for at least one of the following reasons: they are anticipated under 35 U.S.C. § 102; they are obvious under 35 U.S.C. § 103; the specification does not comply with 35 U.S.C. § 112, first paragraph; and the claims do not comply with 35 U.S.C. § 112, second paragraph.”

Defendants, PSC Inc. and PSC Scanning, Inc., have filed a motion to dismiss pursuant to FRCP 12(B)(1) or alternatively to sever and transfer the noninfringement and invalidity counts to the United States District Court for the District of Oregon, Eugene division, where a complaint for infringement of the same patent has been filed. The Ohio court has granted a request by plaintiff, NCR Corporation, to extend the time for filing a response to PSC's motion to dismiss until August 29, 2004.

B. Items CC and CD

On May 5, 2004, PSC Scanning, Inc. filed a complaint for patent infringement against NCR Corporation in the United States District Court for the District of Oregon, Eugene division. The suit is identified as PSC Scanning, Inc. v. NCR Corporation, Civil Action No. 04-06137-AA. The complaint alleges that NCR has infringed the Rando U.S. Pat. No. RE37,166 (the 'RE'166 patent), the parent to the present application. As of the filing of this supplemental information disclosure statement, it is understood that the complaint has not yet been served on the defendant and no answer

has been filed. The court has granted the parties' joint motion to set aside the court's Discovery and Pretrial Scheduling Order.

INFORMATION DISCLOSURE STATEMENT FILING PROVISION:

☐ This IDS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is (1) within three months of the filing date of the application, which is not a continued prosecution application filed under § 1.53(d); or (2) within three months of entry of the national stage as set forth in 37 CFR § 1.491; or (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after filing a request for continued examination under § 1.114. Thus, no fee is required.

☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR § 1.17(p) to the deposit account referenced below.

☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.

☒ This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office action on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311.

☐ The fee due under 37 CFR § 1.17(p) is submitted herewith.

☒ A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.

☐ This IDS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. A statement under 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is submitted herewith.

STATEMENT UNDER 37 CFR § 1.97(e):

☐ Each item contained in this IDS was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.

☒ No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and because these complaints were filed less than three months ago, the attorney or agent signing below hereby states that no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of this information disclosure statement.

☐ Applicant sets forth below concise explanation of the relevance of each document not in the English language and/or selected documents(s) in the English language.

PAYMENT AND/OR AUTHORIZATION TO CHARGE FEES:

- ☐ A check in the amount of _____ is enclosed for the above fee(s).
- ☐ Please charge PSC's Deposit Account No. 13-4953 for the above fee(s).
- ☒ The Commissioner is authorized to charge PSC's Deposit Account No. 13-4953 for any fees which may be required by the filing of this paper by the filing of this paper.¹

Respectfully submitted,

Dated: July 26, 2004

By: John A. Rafter, Jr.
John A. Rafter, Jr.
Reg. No. 31,653

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¹ The Commissioner is authorized to charge Stoel Rives LLP's Deposit Account No. 19-4455 if the above-referenced Account No. 13-4953 has insufficient funds.

258/060

09/745,302

INFORMATION DISCLOSURE STATEMENT

APPLICANT:

Rando et al.

FILING DATE:

December 20, 2000

GROUP:

2876

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE
	AA						
	AB						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION YES NO
	BA						
	BB						

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

	CA	Complaint for Patent Infringement and Declaratory Judgment, <u>NCR Corporation v. PSC, Inc. and PSC Scanning, Inc.</u> , Case No. 3:04cv0142 (S.D. Ohio, Dayton), filed April 30, 2004.
	CB	Civil Docket, <u>NCR Corporation v. PSC, Inc. and PSC Scanning, Inc.</u> , Case No. 3:04cv0142 (S.D. Ohio (Dayton)), printed July 8, 2004.
	CC	Complaint for Patent Infringement, <u>PSC Scanning, Inc. v. NCR Corporation</u> , Civil Action No. 04-6137-AA (D. Oregon, Eugene), filed May 5, 2004.
	CD	Civil Docket, <u>PSC Scanning, Inc. v. NCR Corporation</u> , Civil Action No. 04-6137-AA (D. Oregon (Eugene)), printed July 8, 2004.

EXAMINER:

DATE CONSIDERED:

EXAMINER: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant